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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,892	10/29/2003	Christophe Boule	016800-545	4119

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EXAMINER

YOUNG, SHAWQUIA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/694,892	Applicant(s) BOULLE ET AL.	
	Examiner Shawquia Young	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/25/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 25-47, 51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-52 are currently pending in the instant application.

I. *Priority*

The instant application claims benefit of the Provisional application 60/425,276, filed on November 12, 2002, which claims benefit of the Foreign application FRANCE 02/13522, filed on October 29, 2002.

II. *Restriction/Election*

A. Election: Applicant's Response

Applicants' election with traverse of Group I in the reply filed on July 25, 2006 is acknowledged. The traversal is on the ground(s) that the inventions of Groups I and II should be examined together.

All of the Applicants' arguments have been considered but have not been found persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

The Restriction Requirement detailed the reasons for restriction between the groups. Applicants argue that the inventions of Groups I and II are closely related and that a proper search of any of the claims should require a proper search of the others.

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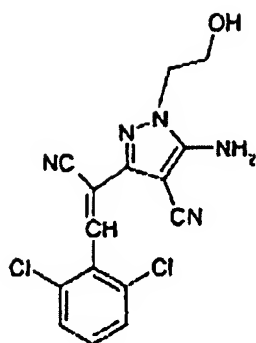
Different search considerations are involved (i.e., class/subclass searches, databases searches, etc.) for each of the groups listed. Group I is classified in 514 whereas Group II is classified in 514 and 548. However, each Class 548 and 514 encompasses numerous patents and published applications. For instance, Class 514 contained 165,171 patents and published applications. Therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

Applicants argue any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. However as mentioned above, 35 U.S.C. 121 gives the Director the authority to restrict the examination of an application to a single invention. Applicants have not presented any evidence that the inventions are not patentably distinct.

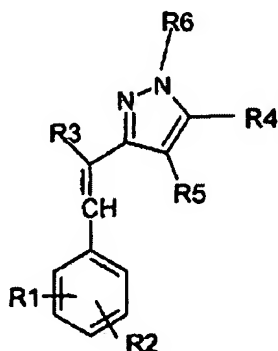
Subject matter not encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

B. Status of the Claims

i. Scope of the Elected Subject Matter



The above structure is the provisional elected species. The scope of the subject matter is the use of the compounds of the formula (I) wherein:



R₁, R₂, R₄, and R₅, which may be identical or different, are chosen from hydrogen, a halogen, NR₇R'₇, and CN, with R₇ and R'₇ independently denoting hydrogen;

R₃ is chosen from CN, COOR₈, CONR₈R'₈, and COR₈, with R₈ and R'₈ independently denoting hydrogen;

R₆ is chosen from hydrogen, COOR₉, CONR₉R'₉, and COR₉, with R₉ and R'₉ independently denoting hydrogen ;

ii. Extended Prior Art Search M.P.E.P. §803.02

If upon examination of the elected species, no prior art is found that would anticipate or render obvious the instant invention based on the elected species, the search of the Markush-type claim will be extended. See M.P.E.P. § 803.02 (2001). If prior art is then found that anticipates or renders obvious the non-elected species, the Markush-type claim will be rejected. It should be noted that the prior art search will not be extended unnecessarily to cover all non-elected species. Should Applicant overcome the rejection by amending the claim, the amended claim will be reexamined. Id. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. Id. In the event prior art is found during reexamination that renders obvious or anticipates the amended Markush-type claim, the claim will be rejected and the action made final. Id.

As indicated above, Examiner searched the compound based on the elected species, above, in response to the requirement to restrict the products of Formula (I), wherein: there was no prior art of record that anticipated or rendered obvious the elected species and therefore the scope of the subject matter was **extended or broaden** in pursuant to M.P.E.P. § 803.02.

The prior art search was extended to include the use of the products of formula (I) wherein:

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R₁ , **R₂**, **R₄**, and **R₅** are as defined in claim 1 excluding heterocyclic or heteroaryl groups;

R₃ is chosen from CN, COOR₈ , CONR₈R'₈, COR₈, SO₂R₈, and SO₂NR₈R'₈ with **R₈** and **R'₈** independently denoting hydrogen, a linear or branched C₁₋₂₀ alkyl radical or a ring of 4 to 7 atoms, isolated or fused to another ring, the alkyl radical or the said ring being saturated or unsaturated and optionally substituted with at least one substituent **A₃**;

R₆ is chosen from hydrogen, COOR₉ , CONR₉R'₉, COR₉, SO₂R₉, and SO₂NR₉R'₉ with **R₉** and **R'₉** independently denoting hydrogen, a linear or branched C₁₋₂₀ alkyl radical or a ring of 4 to 7 atoms, isolated or fused to another ring, the alkyl radical or the said ring being saturated or unsaturated and optionally substituted with at least one substituent **A₅**;

A₁, **A₂**, **A₃**, **A₄**, and **A₅** are as defined in claim 1 excluding heterocyclic and heteroaryl groups.

iii. Non-elected Subject Matter Withdrawn 37 C.F.R. §1.142(b)

The non-elected subject matter withdrawn are the use of the compounds of the formula (I) wherein:

R₁ , **R₂**, **R₄**, and **R₅** are heterocyclic or heteroaryl groups;

R₇, **R'₇**, **R''₇**, and **R'''₇** are heterocyclic or heteroaryl groups;

R₈ and **R'₈** are heterocyclic or heteroaryl groups;

R_9 and R'_9 are heterocyclic or heteroaryl groups;

R_{10} , R'_{10} , R''_{10} , and R'''_{10} are heterocyclic or heteroaryl groups.

III. *Rejection(s)*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The phrases "Use of an effective amount...", "Cosmetic use of at least one..." and "Use of at least one..." are written in improper format because a "use" can only be properly claimed as a process or method. It is suggested that applicant amend the claims by rewriting the claims as a process or method, i.e. "a method of inducing and/or stimulating the growth, reduce the loss and/or increase the density of keratin fibres ..."

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 and 48-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite and unclear. In claims 1-24 and 48-50 for the definition of variable R_6 , it is unclear if the possible groups that R_6 can be chosen from ends with the terms "and $SO_2NR_9R'_9$ " or does it also include the following phrase "linear or branched, saturated or unsaturated C_{1-20} alkyl radicals and saturated or unsaturated rings of 4 to 7 atoms.....".

The latter phrase is also being used to define the substituents R₉ and R'₉ within the definition of R₆.

Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically the phrase "comprising at least one compound of formula (I) or a salt thereof" renders the claims indefinite, as the compound of formula (I) is not defined in the instant claim. The examiner must refer back to the instant specification to find the definition of the compound of formula (I). A claim referring to the specification is improper except in rare instances and fails to particularly point out the subject matter that applicant regards as the invention. Ex parte Fressola, 27 USPQ 2d 1608 (1993).

Claims 3, 5, 6, 8 and 10 are process claims and are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps need to show the process steps involved in the preparation or manufacture of a care or treatment composition involving at least one styrylpyrazole compound of formula I. Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph for being dependent upon claims 3, 5, 6, 8 and 10.

IV. Objections

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The specification to which the oath or declaration is directed has not been adequately identified. The title of the specification is not in English. See MPEP § 602.

Specification

The abstract of the disclosure is objected to because there is a missing period at the end of the abstract. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 22 is objected to because of the following informalities: missing a period at the end of the claim. Each claim begins with a capital letter and ends with a period (MPEP 608.01 (m)). Claim 22 is also missing the term “and” between the last two compounds 10 and 11 and commas between compounds 1-10. Appropriate correction is required.

Claims 11-24 and 48 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim. See MPEP § 608.01(n). For example, claim 11 is a multiple dependent claim

that depends on claim 6 which is a multiple dependent claim. It is suggested that applicant delete the multiple dependent claim from the list, i.e. any one of claims 1-5, 7, 9, etc. It is further suggested that applicant adds the term "one" preceding the phrase "of claims 25 to 47..." in claim 48.

Claim Objection-Non Elected Subject Matter

Claim 1-24 and 48-50 is objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

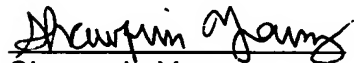
V. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

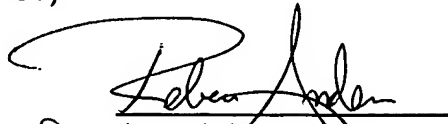
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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